

REMARKS

Claims 1-9 are pending in this application.

Double Patenting Rejections

- A. Response to provisional rejection of claims 1-9 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 14-26 of copending Application No. 10/577,270 (US 2007/0078224) of Dominic et al.

In response to the provisional rejection of claims 1-9 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 14-26 of copending Application No. 10/577,270 (US 2007/0078224) of Dominic et al. ("Dominic"), Applicants respectfully traverse the rejection.

First and foremost, the instant application has a filing date of **December 16, 2004**, whereas co-pending U.S. Patent Application Serial No. 10/577,270 has a filing date of **April 26, 2006**. Therefore, the instant application is the earlier filed pending application, while U.S. Patent Application Serial No. 10/577,270 is the later filed co-pending application. As such, Applicants respectfully believe the instant double patenting rejection should be withdrawn in conjunction with MPEP §804 (I)(B)(1), which states,

If a 'provisional' nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer. If the ODP rejection is the only rejection remaining in the later-filed application, while the earlier-filed application is rejectable on other grounds, a terminal disclaimer must be required in the later-filed application before the rejection can be withdrawn.

Notwithstanding the above, Applicants traverse the Rejection as improper for not meeting requirements set forth under Federal Circuit law and the MPEP. In particular, when considering whether the subject matter defined in a claim of an application would have been an obvious variation of the subject matter defined in the claim of a patent, or another patent application, the disclosure of the patent or other patent application may not be used as prior art. *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 1279, 23 USPQ2d 1839, 1846 (Fed. Cir. 1992), (Emphasis added).

In an argument supporting the rejection, the Examiner stated in the Office Action that

[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because the compositional limitations for the polymers and for the constituents included therein overlap. (page 2, lines 26-29)

However, the pending claims relate to a polyolefin composition in claim 1 and its dependent claims, a process for making polyolefin compositions in claim 6 and its dependent claims, and injection molded articles made from the polyolefin composition in claim 9.

Claim 1 recites:

Polyolefin compositions comprising, in percent by weight based on a total weight of the polyolefin compositions:

- 1) 55-90% of a crystalline propylene homopolymer or copolymer containing up to 15% of at least one of ethylene and C₄-C₁₀ α -olefin(s) and having a value of MFR (230 °C, 2.16 kg) of at least 25 g/10 min; and
- 2) 10-45% of a copolymer of ethylene with at least one C₄-C₁₀ α -olefin(s) containing from 10 to 40% of said C₄-C₁₀ α -olefin(s);

said compositions having MFR values of at least 20 g/10 min, a total content of ethylene of at least 20%, a total content of C₄-C₁₀ α -olefin(s) of at least 4.5%, a ratio of the total content of ethylene to the total content of C₄-C₁₀ α -olefin(s) of at least 2.3, a total fraction soluble in xylene at room temperature of less than 18 wt% and an intrinsic viscosity value of the fraction soluble in xylene at room temperature of at most 1.7 dl/g.

In arguing that Dominic's claims and those currently recited overlap, the Examiner apparently referred to the possibility of overlap in only the compositional amounts of two components in Dominic's 3-component system with the 2-component system of the current claims, but there is clearly no overlap in the limitations directed to the composition as a whole. In fact, none of Dominic's claims recite a limitation directed to the composition as a whole, as in the currently recited claims. Therefore, Dominic's claims do not recite:

- (1) a total content of ethylene,
- (2) an MFR of the total composition,

- (3) a total content of C₄-C₁₀ α -olefins,
- (4) a ratio of the total content of ethylene to the total content of C₄-C₁₀ α -olefins,
- (5) a total fraction soluble in xylene, and
- (6) an intrinsic viscosity of the fraction soluble in xylene.

With respect to claims 6-10, Dominic does not recite any process or article claims.

Additionally, even if some of the constituents of the currently pending claims do overlap with some of the constituents of the currently pending claims for co-pending U.S. Patent Application Serial No. 10/577,270 as purported by the Examiner, which Applicant respectfully denies as outlined above, this in and of itself is not sufficient to establish a *prima facie* case of double patenting. See MPEP §804 and §804 II. In fact, in order to establish a *prima facie* case of obviousness-type double patenting, it is incumbent on the Examiner to: (I) determine the scope and content of the claims at issue; (II) determine the differences between the scope and content of the claims at issue; (III) determine the level of ordinary skill in the pertinent art; and (IV) evaluate any objective indicia of nonobviousness. Additionally, any obviousness-type double patenting rejection should make clear: (A) the differences between the inventive subject matter defined by the conflicting claims; and (B) the reasons *why* a person of ordinary skill in the art would conclude that the inventive subject matter defined in the claim at issue is anticipated by, or would have been an obvious variation of, the inventive subject matter defined in a claim of the co-pending application. See MPEP §804(I)(B)(1). However, since the Examiner has not made clear: (A) the differences between the subject matter defined by the conflicting claims; and (B) *why* a person of ordinary skill in the art would conclude that the subject matter defined in the currently rejected claims are anticipated by, or would have been an obvious variation of, the subject matter defined in a claim in the cited co-pending U.S. Patent Application, Applicants respectfully traverse the current rejection.

Reconsideration and withdrawal of the rejection respectfully is requested.

- B. Response to rejection of claims 1-9 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,441,094 of Cecchin et al. ("Cecchin").

In response to the rejection of claims 1-9 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,441,094 of Cecchin et al. ("Cecchin"), Applicants respectfully traverse the Rejection.

The requirements for an obviousness-type double patenting rejection have been summarized in paragraph A above.

In support of the rejection, the Examiner has argued that

[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because the compositional limitations for the polymers and for the constituents included therein overlap. The identical composition may be embraced by the patented claims. (page 3, lines 3-6) (Emphasis added)

Applicants disagree with the Examiner's assertion that Cecchin discloses an identical composition. First, Cecchin's claims recite a 3-component system (A^I, A^{II}, and B), in contrast to the 2-component system of the current claims. Moreover, at the least, Cecchin's claims do not recite:

- (1) a total content of ethylene of at least 20%,
- (2) a total content of C₄-C₁₀ α -olefin(s) of at least 4.5%, or
- (3) a ratio of the total content of ethylene to the total content of C₄-C₁₀ α -olefin(s) of at least 2.3.

Clearly, a person of ordinary skill in the art would not conclude that the subject matter recited in the current claims is anticipated by, or would have been an obvious variation of, the subject matter defined in a Cecchin's claims.

Moreover, as discussed above, even if some of the constituents of the currently pending claims do overlap with some of the constituents of the claims for U.S. Patent 6,441,094, this in and of itself is not sufficient to establish a *prima facie* case of double patenting. See MPEP §804 and §804 II. In fact, in order to establish a *prima facie* case of obviousness-type double patenting, it is incumbent on the Examiner to: (I) determine the scope and content of the claims at issue; (II) determine the differences between the scope and content of the claims at issue; (III) determine the level of ordinary skill in the pertinent art; and (IV) evaluate any objective indicia of nonobviousness. Additionally, any obviousness-type double patenting rejection should make clear: (A) the differences between the inventive subject matter defined by the conflicting claims;

and (B) the reasons *why* a person of ordinary skill in the art would conclude that the inventive subject matter defined in the claim at issue is anticipated by, or would have been an obvious variation of, the inventive subject matter defined in a claim of the co-pending application. See MPEP §804(I)(B)(1). However, since the Examiner has not made clear: (A) the differences between the subject matter defined by the conflicting claims; and (B) *why* a person of ordinary skill in the art would conclude that the subject matter defined in the currently rejected claims are anticipated by, or would have been an obvious variation of, the subject matter defined in a claim in the cited U.S. Patent, Applicants respectfully traverse the current rejection.

Reconsideration and withdrawal of the rejection respectfully is requested.

Rejections Under 35 U.S.C. § 102

C. Response to rejection of claims 1-9 under 35 U.S.C. §102(e) as being anticipated by Cecchin.

In response to the rejection of claims 1-9 under 35 U.S.C. §102(e) as being anticipated by Cecchin, Applicants respectively traverse the rejection.

For a reference to anticipate an invention, all of the elements of that invention must be present in the reference. The test for anticipation under section 102 is whether each and every element as set forth in the claims is found, either expressly or inherently, in a single prior art reference. *Verdegaal Bros. V. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must also be arranged as required by the claim. *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

The Examiner has not commented specifically on where in Cecchin the elements of any of the pending claims are disclosed, except to generally cite the claims and the specification.

With regard to the rejection of claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Cecchin et al (US 6,441,094), the basis for the rejection is shown clearly in the claims of the reference. However, when the metes and bounds of the claims cannot be clearly ascertained from reading the claims themselves, it is necessary to view the Specification with an understanding of the metes and bounds of the scope of the invention being claimed. The claim language herein does not exclude the presence of other constituents, even in major amounts. (page 5, lines 14-20)

First, with respect to Cecchin's claims, as discussed above, they clearly do not recite: (1) a total content of ethylene of at least 20%, (2) a total content of C₄-C₁₀ α-olefin(s) of at least 4.5%, or (3) a ratio of the total content of ethylene to the total content of C₄-C₁₀ α-olefin(s) of at least 2.3. Moreover, there is no particular teaching in Cecchin's specification as to the combination of the claimed elements, or specifically, the total ethylene content of its compositions. The compositions of four examples are listed in Table 1, however, the ethylene content of examples 1-4 are 16.8, 14.2, 16.4, and 18.4%, respectively, and those clearly do not teach the recited total ethylene content. Finally, with respect to the limitation directed to melt flow rate, Cecchin discloses a vast range (equal to or higher than 4 g/10 min., in particular equal to or higher than 5 g/10 min., col. 1, lines 63-67), however, Applicants respectively submit that such a range does not disclose Applicants' claimed range with sufficient specificity to anticipate the claims as required under §102.

Therefore, for all the above reasons, Applicants respectively submit that the cited reference does not teach all the elements of the current claims, and request reconsideration and withdrawal of the Rejection.

Information Disclosure Statement

Applicants have included with this Response a Supplemental Information Disclosure Statement. Acknowledgement and consideration of the references listed on the accompanying PTO 1449 form is respectfully requested.

The Commissioner is hereby authorized to charge U.S. PTO Deposit Account 08-2336 in the amount of any fee required for consideration of this Response.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited with sufficient postage thereon with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on March 23, 2009.



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